

REMARKS

The Examiner objected to the Abstract for allegedly reciting terms such as “means” and “said.” Applicants review revealed no recitation of the term “means” in the Abstract. Applicants have revised the Abstract to eliminate recitations of “said.”

Rejection Under 35 U.S.C. § 101

The rejection of claim 41 under 35 U.S.C. § 101 has been rendered moot, since Applicants have, solely for the purpose of expediting allowance, cancelled claim 41.

Rejection Under 35 U.S.C. § 112

The Examiner rejected claims 40 and 41 under 35 U.S.C. § 112, first paragraph, for lack of enablement. Applicants respectfully traverse. Indeed, contrary to the Examiner’s assertion that “the specification is silent with respect to methods of obtaining whole plants,” the specification clearly recites methods of transformation and regeneration. See, for example, page 18 line 30 to page 19 line 5, which recites EP 0292435 and US application No. 08/024,875 (now granted as US 5,350,689) and incorporates these applications by reference. Both of these documents explicitly describe how to transform plant cells and regenerate whole plants from such transformed cells.

In addition, even if, assuming *arguendo*, there is some unpredictability associated with controlled, receptor gene-mediated expression of target genes in transgenic plants generally, it is not determinative with respect to enablement of the claimed invention. Absolute predictability is not required to satisfy § 112.

For these reasons, Applicants respectfully submit that the Examiner has not shown that the instant application fails to provide sufficient disclosure in accordance with § 112.

Nevertheless, solely to expedite allowance of this case, Applicants have amended claim 40 to recite “a plant cell,” since the Examiner has already acknowledged that the specification is enabling for plant cells. (See Office Action, page 5, last line.) As such, reconsideration and withdrawal of this rejection is respectfully requested.

The rejection of claim 41 under 35 U.S.C. § 112, first paragraph, has been rendered moot since the claim has been cancelled solely in order to expedite prosecution. Applicants respectfully disagree with the Examiner’s position. As discussed above, the specification is fully enabled with respect to the production of intact plants, and once in possession of an intact plant it is merely a matter of routine to isolate seeds from such plants. The presence of an expression cassette of the invention in the plant or seed can be detected using PCR based detection methods on suitable prepared plant or seed tissue, and such detection would be considered as a routine procedure by the skilled artisan.

Applicants reiterate that the claims are fully enabled. Applicants reserve the right to pursue the subject matter covered by the original claims in a continuing application, and respectfully reiterate that the amendment of claim 40 and cancellation of claim 41 are not intended to reflect acquiescence to the rejections.

Rejection Under 35 U.S.C. § 103

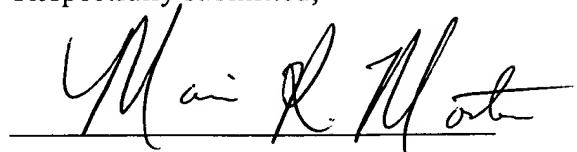
Claims 26 and 39, among others, (which depends therefrom) were rejected for allegedly being unpatentable over Schena et al. in view of Koelle et al and Christoperson et al. Claims 26 and 39, were also rejected for allegedly being unpatentable over Schena et al. in view of Evans et al. (WO94/01558). However, the Examiner noted that claim 30 (which previously depended from claim 26) has been deemed free of the prior art since the prior art’s failure to teach or

suggest the claimed combination of C1 regulatory gene of maize with other receptor gene domains under the control of a plant promoters. Hence, solely to expedite allowance, Applicants have essentially re-written claim 30 in independent form (as suggested by the Examiner) by amending claim 26 to incorporate the features of claims 27-30). Applicants stress that amendment is merely to expedite prosecution and is not to be construed as an admission that the Examiner is correct in his assertions. Applicants reserve the right to pursue the original claims in a continuing application.

The rejections of claims 28, 29, 31, 32-35, and 37-39 under 35 U.S.C. § 103 for obviousness have been rendered moot, since those claims have been cancelled solely to expedite allowance of the remaining claims. Applicants stress that this cancellation is merely to expedite prosecution and is not to be construed as an admission that the Examiner is correct in his assertions. Applicants reserve the right to pursue these claims in a continuing application.

The Examiner is respectfully requested to enter the above amendments and reconsider the rejections in view of the amendments and Remarks set forth above, and withdraw the rejections. If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call Applicants' undersigned attorney.

Respectfully submitted,



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